

REMARKS

At the time of the Second Office Action dated October 30, 2007, claims 1-12 were pending and rejected in this application.

**CLAIM 1 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
KIYAMA ET AL., U.S. PATENT NO. 5,642,518 (HEREINAFTER KİYAMA), IN VIEW OF HO ET AL.,
U.S. PATENT NO. 6,571,240 (HEREINAFTER HO)**

On pages 3-5 of the Second Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Kiyama in view of Ho to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 1

Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of nonobviousness.¹ Upon reviewing the Examiner's statement of the rejection, Applicants respectfully submit that the Examiner has failed to properly characterize the differences between the claimed invention and the prior art.

¹ See *KSR Int'l v. Teleflex Inc.*, 550 U.S. ____ (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

Specifically, in the first full paragraph on page 4 of the Second Office Action, the Examiner asserted the following:

However, Kiyama *et al* does not specifically teach the dictionary specific to a particular domain.

This characterization of the teachings of Kiyama is incomplete. As claimed, not only is the dictionary specific to a particular domain, the particular domain is also associated with the content, and this feature is not taught by Kiyama. Moreover, the dictionary is of words and phrases, and this feature is also not taught by Kiyama. Still further, the list of keyword candidates comprises a plurality of words and phrases, yet Kiyama only describes words. Moreover, the list of keyword candidates is also specific to a particular domain, which is also not disclosed by Kiyama. Therefore, the Examiner has failed to properly characterize the differences between the claimed invention and Kiyama.

On pages 4 and 5 of the Second Office Action, the Examiner further asserted the following:

Ho *et al.* does teach a dictionary of words and phrases specific to a particular domain (see col. 6, lines 62-col. 7, lines 3, domain specific dictionary) associated with the text (see col. 4, lines 40-50, phrases from documents).

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have modified the keyword generation systems as taught by Kiyama *et al.* with the inclusion of a domain-specific dictionary as taught by Ho *et al.* The motivation to have included such a dictionary is for quicker retrieval (see col. 4, lines 20-23) for information related to a specific domain and to include commonly used terms and meanings in a particular domain (see col. 6, lines 62-col. 7, lines 3) for reduction in memory as would be apparent to one skilled in the art. (emphasis added)

At the outset, Applicants note that Kiyama and Ho, either alone or in combination, teach the claimed "a list of keyword candidates comprising a plurality of words and phrases specific to said particular domain." Thus, even if one having ordinary skill in the art would have been motivated to modify Kiyama in view of Ho, the claimed invention would not result.

Applicants also note that the Examiner asserted motivation for the combination (i.e., "for reduction in memory as would be apparent to one skilled in the art") is completely unsupported by the teachings of the applied prior art. A discussion of "reduction is memory" is nowhere to be found in the teachings of Ho. Moreover, the teachings of Ho actually teach the opposite. Specifically, referring to Fig. 4 and column 6, lines 31-36, Ho describes the use of three separate dictionaries (i.e., a common dictionary 202, a negative dictionary 204, and a domain-specific dictionary 206), which would increase the amount of memory needed, as compared to the "keyword-negligible word dictionary d" taught by Kiyama. Since the Examiner's proposed common sense rationale for modifying Kiyama in view of Ho is not supported by the teachings of the applied prior, Applicants must presume that the Examiner's only rationale for combining the applied prior art in the manner suggested was based upon impermissible hindsight reconstruction based upon the teachings of Applicants' disclosure. Thus, Applicants' position is that the Examiner has failed to establish a proper prima facie case of obviousness.

Therefore, for the above-described reasons, Applicants respectfully submit that the imposed rejection of claim1 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Ho is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 3, 7-8, AND 12 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASEED UPON KIYAMA**

On pages 5-7 of the Second Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Kiyama to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 3 and 8

On page 5 of the Second Office Action, the Examiner asserted the following:

locating words and phrases in a selected portion of content (see col. 4, lines 58-60), said words and phrases being specific to a particular domain (see col. 1, lines 4-5) (e.g. In the reference that keywords associated with a domain type is extracted and is thus specific to a particular domain depending on the word detected).;

Applicants respectfully disagree with the Examiner's analysis. Although the Examiner asserts that column 4, lines 58-60 discloses the claimed "locating words and phrases in a selected portion of content," Applicants do not agree. This passage cited by the Examiner refers to "words" but not "phrases." Moreover, the passage cited by the Examiner does not refer to a "selected portion" of content. Regarding the claimed "said words and phrases being specific to a particular domain," Applicants incorporate herein, as also applying to the present rejection, the arguments previously presented with regard to similar terminology found in claim 1.

On page 6 of the Second Office Action, the Examiner admitted that Kiyama does not specifically teach selecting portion of content. The Examiner further asserted the following:

It would have been obvious to modify the keyword generation as taught by Kiyama et al with the selection of a portion of the text for the purpose of an alternative method to obtain textual data from the entire text on hand.

Applicants note that the Examiner's asserted rationale (i.e., "for the purpose of an alternative method") could be used to reject any set of claim language. As such, the Examiner's assertion is little more than a generalization that would not have realistically impelled one having ordinary skill in the art to arrive at the claimed invention.

Therefore, for the above-described reasons, Applicants respectfully submit that the imposed rejection of claims 3, 7-8, and 12 under 35 U.S.C. § 103 for obviousness based upon Kiyama is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 2 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KIYAMA
IN VIEW OF HO AND HITA ET AL., U.S. PATENT NO. 6,081,774 (HEREINAFTER HITA)**

On page 7 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kiyama in view of Ho and Hita to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 2 depends from independent claim 1, and Applicants incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Ho. The tertiary reference to Hita does not cure the argued deficiencies of the combination of Kiyama and Ho. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Kiyama and Ho in view of Hita, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Ho and Hita is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 4 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KİYAMA IN VIEW OF HITA ET AL., U.S. PATENT NO. 6,081,774 (HEREINAFTER HITA)

On pages 7 and 8 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kiyama in view of Hita to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 4 and 9 respectively depend from independent claims 3 and 8, and Applicants incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 3 and 8 under 35 U.S.C. § 103 for obviousness based upon Kiyama. The secondary reference to Hita does not cure the argued deficiencies of Kiyama. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Kiyama in view of Hita, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 4 and 9 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Hita is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 5-6 AND 10-11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KİYAMA IN VIEW OF YOSHIMI ET AL., U.S. PATENT NO. 6,374,209 (HEREINAFTER YOSHIMI)

On pages 8-10 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kiyama in view of Yoshimi to arrive at the claimed invention. This rejection is respectfully traversed.

On page 9 of the Second Office Action, the Examiner asserted the following:

However, Kiyama *et al.*, does not specifically teach the detecting a variation in font attributes.

Yoshimi *et al.* does teach the detecting of words based upon font attributes (see col. 13, lines 1-35, character ornament, style and size is detected for important word).

It would have been obvious to one of ordinary skilled in the at the time the invention was made to have modified the key word generation taught by Kiyama *et al.* with the inclusion of font detection as taught by Yoshimi *et al.* The motivation to have combined the two references involves the distinction between important words and unimportant words comparing other words in the text [see Yoshimi et at, col. 13, lines 1-35) for faster retrieval of possible keywords, which benefits the keyword generation presented by Kiyama et at by detecting keywords denoted by font to be important as an alternative method for keyword detection.

Applicants respectfully submit that the Examiner's proposed combination is not supported by the teachings of Kiyama and Yoshimi. At the outset, Applicants note that Yoshimi describes locating words based upon font attributes for the purpose of analyzing text structure. This is not comparable to generating a list of keywords for particular content. Also, although the Examiner asserts that distinguishing between important words (i.e., allegedly those words with a variation in font attributes) and unimportant words, the Examiner has failed to establish that one having ordinary skill in the art, based upon the teachings of Kiyama, would consider that distinguishing words or phrases by importance would be valuable.

Based upon the teachings of Kiyama, apparently all of the words within the content are parsed and the results stored in a word partition table b (see column 4, lines 61-63). Thus, all the words in the content are already added to "said list of keyword candidates." Since, as taught by Kiyama, all the words in the content are added the list of keyword candidates, there would be no need to "[select] a string in said selected portion of content affect by said variation," as claimed, and "[add] said string to said list of keyword candidates." To do so would be redundant, and thus not obvious. Applicants, therefore, respectfully submit that the imposed rejection of claims 5-6

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and 10-11 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Yoshimi is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320